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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,693	02/22/2002	Patrick James Richards JR.	RSW920020021US1	5309

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IBM CORPORATION
IPLAW IQ0A/40-3
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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,693

Applicant(s)

RICHARDS ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-10 have been considered.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 5 I. Claims 1-5 are drawn to a method for accessing information using a public key as authorization, classified in class 713, subclass 182 (Electrical Computers and Digital Processing Systems: System Access Control Based on User Identification by Cryptography). Authorization is provided in this method based on one single test, the matching of a public key.
- 10 II. Claims 6-10 are drawn to a method for accessing information using a combination of a public key and a generated sequence number as authorization, classified in class 713, subclass 184 (Electrical Computers and Digital Processing Systems: System Access Control Based on User Identification by Cryptography: PIN/Password Generator Device). Authorization in this method requires two separate tests, the matching of a public key and
- 15 the matching of a sequence number. This method is distinct from invention I because it requires two tests, not one test as in invention I. This method has a separate classification in the art because it requires a sequence generator (password generator).

20 Inventions [I] and [II] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

25 In the instant case, the combination (II) as claimed does not require the particulars of the subcombination (I) as claimed because the combination does not require step k of the subcombination, "if the step of comparing the check word and the data user public key indicates that the check word and the data user key match, recording permission to transfer the information in an access list". Put simply, this step is "if a key matches, record permission". The combination has step n, "if the step of comparing the

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check word and the data user public key indicates that the check word and the data user public key match, and further if the step of comparing the check number and an expected sequence number indicates that the check number and the expected sequence number match, recording permission to transfer the information in an access list". Put simply, this step is "if a key matches AND a sequence number matches, record permission". To put this in logical terms, the combination (II) is "IF A and B, THEN C" while the subcombination (I) is "IF A, THEN C". The combination merely requires "A", not "IF A, THEN C". Not only does the combination not require the step "IF A, THEN C", the combination also precludes the use of "IF A, THEN C" as this is a separate logical function which would not require both A and B and hence could not satisfy checking both the key (A) and the sequence number (B).

The second part of the combination/subcombination requirement is that the subcombination has utility by itself or in other combinations. In the instant case, the subcombination could be used in a system which only checks the key for authorization, not a sequence number.

Because the inventions are distinct for the reasons given above and have acquired a separate status in the art as seen by their separate classification in the restriction, restriction for examination purposes is proper. A complete response to this action must include an election of the group to be examined, even if the requirement is traversed.

Conclusion

A shortened statutory period for response is set to expire one month (not less than 30 days) from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
5 you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS

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EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER